REMARKS

Claims 1-3 and 9-16 are pending in the Application.

Claims 1-3 and 9-16 stand rejected.

Applicants thank the Examiner for discussing the office action and in particular the Examiner's response to Applicants' arguments on October 16, 2003. The Examiner acknowledged that he may not have addressed each of Applicants' arguments presented in the response dated July 28, 2003. The Examiner consequently informed Applicants to restate any arguments that the Examiner did not address in this response.

I.   REJECTIONS UNDER 35 U.S.C. § 103:

Claims 1-2, 9-10, 12-14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mann (U.S. Patent No. 6,295,534) in view of Rathbun (U.S. Patent No. 6,138,123). Claims 3, 11 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mann in view of Rathbun in further view of Dinwiddie et al. (U.S. Patent No. 5,113,522) (hereinafter "Dinwiddie").

A.   Mann and Rathbun, taken singly or in combination, do not teach or suggest the following limitations.

Applicants respectfully assert that Mann and Rathbun, taken singly or in combination, do not teach or suggest "whenever a new activity begins, inserting the new activity at a top of the list" as recited in claim 1 and similarly in claims 9 and 13. Applicants further assert that Mann and Rathbun, taken singly or in combination, do not teach or suggest "whenever an activity in the ordered list completes, removing the completed activity from the ordered list" as recited in claim 1 and similarly in claims 9 and 13. The Examiner admits that Mann fails to teach these limitations. Further, the Examiner has not cited any language in Rathbun where these limitations are taught or suggested.

Instead, the Examiner asserts that it is common knowledge in the art that new items/activities to the data structure should be added or inserted to the ordered list, and that it is common knowledge in the art that items/activities that are completed should be removed from the ordered list.

Applicants respectfully traverse these assertions of what is common knowledge in the art, and respectfully assert that the Examiner must provide a reference that supports these assertions. M.P.E.P. § 2144.03. Further, it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as a principle evidence upon which a rejection was based. *In re Zurko*, 258 F.3d 1379, 1385, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001). Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-2, 9-10, 12-14 and 16.

The Examiner's stated motivation for modifying Mann to insert a new activity at the top of a list when a new activity begins and for modifying Mann to remove a completed activity from the ordered list when the activity in the ordered list completes is "for improving the control of data." Paper No. 6, page 3. This is the Examiner's own subjective opinion which is insufficient to support a *prima facie* case of obviousness. The Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Mann to insert a new activity at a top of a list when a new activity begins. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Mann to remove a completed activity from the ordered list when the activity in the ordered list completes. *Id.*

Applicants further assert that Mann and Rathbun, taken singly or in combination, do not teach or suggest "displaying the activity that is at the top of the list" as recited in claim 1 and similarly in claims 9 and 13. The Examiner admits that Mann fails to teach displaying the activity that is at the top of the list. The Examiner further fails to cite any language in Rathbun where this limitation may be taught or suggested. Instead, the Examiner asserts that this limitation is obvious for reasons of

improving the usability for the user and it would be convenient to the user if it had displayed the activity of interest.

Again, the Examiner is simply relying on his own subjective opinion in support of such an obviousness assertion. The Examiner must submit objective evidence and cannot rely on his own subjective opinion. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, if the Examiner is asserting that it is common knowledge to display the activity that is at the top of the list, Applicants respectfully assert that the Examiner must provide a reference that supports such an assertion. M.P.E.P. § 2141.03. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1, 9 and 13. M.P.E.P. §2143.

Claims 2, 10, 12, 14 and 16 recite combinations of features including the above combinations, and thus they are patentable for at least the above reasons as well. Claims 2, 10, 12, 14 and 16 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Mann in view of Rathbun.

For example, Mann and Rathbun, taken singly or in combination, do not teach or suggest "wherein the displaying step displays a code pertaining to the latest-started activity that has not completed" as recited in claim 2 and similarly in claims 10 and 14. The Examiner admits this limitation is not taught in Mann, and fails to cite any language in Rathbun. Instead, the Examiner asserts that this limitation is obvious for reasons of improving the usability for the user and it would be convenient to the user if it had displayed the activity of interest.

Again, the Examiner is simply relying on his own subjective opinion in support of such an obviousness assertion. The Examiner must submit objective evidence and cannot rely on his own subjective opinion. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, if the Examiner is asserting that it is common knowledge to display a code pertaining to the latest-started activity that has not completed, Applicants

respectfully assert that the Examiner must provide a reference that supports such an assertion. M.P.E.P. § 2141.03. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 2, 10 and 14. M.P.E.P. §2143.

Applicants further assert that Mann and Rathbun, taken singly or in combination, do not teach or suggest "circuitry for determining if an activity that has completed is currently being displayed; and if the activity that has completed is currently being displayed, circuitry for displaying an activity that had previously been displayed" as recited in claim 12 and similarly in claim 16. The Examiner admits this limitation is not taught in Mann, and fails to cite any language in Rathbun. Instead, the Examiner asserts that this limitation is obvious for reasons of improving the usability for the user and it would be convenient to the user if it had displayed the activity of interest. Further, the Examiner asserts that this limitation is inherent.

Again, the Examiner is simply relying on his own subjective opinion in support of such an obviousness assertion. The Examiner must submit objective evidence and cannot rely on his own subjective opinion. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Further, Applicants respectfully traverse the assertion that it is inherent that there are condition statements created and set by the programmer that make the decisions on whether or not the activity is to be displayed. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, in order for the Examiner to establish inherency, the Examiner must provide extrinsic evidence that must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Inherency, however, may not be established by probabilities or possibilities. *Id*. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id*. Therefore,

the Examiner must support the inherency argument with objective evidence meeting the above requirements. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 12 and 16. M.P.E.P. §2143.

B.   The Examiner has not provided any objective evidence for combining Mann with Rathbun.

A *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

In order to reject under 35 U.S.C. § 103, therefore, the Examiner must provide a proper motivation for combining or modifying the references. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998); M.P.E.P. § 2142. The Examiner's motivation for modifying Mann with Rathbun to track activities running in parallel, as recited in claim 1, is in order to "increase the speed and power of the system for maintenance of the ordered list of data." Paper No. 6, page 3. This motivation is insufficient to support a *prima facie* case of obviousness, since it is merely the Examiner's subjective opinion, unsupported by any facts.

Mann teaches an ordered list which can store any type of number of data items. Abstract. Mann further teaches that the data to be stored in the ordered list is stored as a plurality of data cells, each comprising any number of bits. Abstract.

Rathbun, on the other hand, teaches creating parallel data structures and associated maintenance programs. Abstract.

The Examiner must submit <u>objective</u> evidence (facts) and not rely on his own <u>subjective</u> opinion in support of combining the reference that teaches storing and modifying an ordered list suitable for use in data communications and other equipment with a reference that teaches creating parallel data structures and associated maintenance programs. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Mann to track activities running in parallel. *Id.* Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Mann to increase the speed and power of the system for maintenance of the ordered lists of data. *Id.* The Examiner has not provided any objective evidence but instead relies on his own subjective opinion. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-2, 9-10, 12-14 and 16.

C.   By combining Mann with Rathbun, the principle of operation of Mann would change.

If the proposed modification or combination of the prior art would change the principle of the operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349, (C.C.P.A. 1959). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). For the reasons discussed below, Applicants submit that by combining Mann with Rathbun, the principle of operation in Mann would change and subsequently render the operation of Mann to perform its purpose unsatisfactory.

Mann teaches using the push or pop operation to insert or remove items from an ordered list where the information inserted or removed in the ordered list is stored in data cells which are in units stacked one on top of another in a linear fashion. Abstract; column 3, lines 66-column 4, line 5.

Rathbun, on the other hand, teaches inserting and removing data in an ordered list in a parallel fashion. Column 2, lines 23-47. Rathbun further teaches that the insert and remove operations may be executed in parallel since the order list is comprised of sublists. Column 2, lines 23-47.

By combining Mann with Rathbun, the push and pop, i.e., the insert and remove operation, would be executed in parallel. However, since the data is stored in the ordered list in a linear fashion, the push and pop operation would be inserting and removing the inappropriate data in the ordered list. This is, because the ordered list in Mann does not comprise sublists, Mann cannot execute the push or the pop operations in parallel as required by Rathbun. Thus, by combining Mann with Rathbun, the principle of operation in Mann would change and subsequently render the operation of Mann to perform its purpose unsatisfactory. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-2, 9-10, 12-14 and 16.

D.   Mann, Rathbun and Dinwiddie, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that Mann, Rathbun and Dinwiddie, taken singly or in combination, do not teach or suggest, "wherein the activities are configurations of devices attached to the data processing system" as recited in claim 3 and similarly in claims 11 and 15. The Examiner cites column 84, line 55 of Dinwiddie as teaching the above-cited claim limitation. Paper No. 3, page 6. Applicants traverse and assert that Dinwiddie teaches instead I/O devices that are configured. This language does not teach that the configured devices are activities that are tracked. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

E.   The Examiner has not provided objective evidence for combining Mann and Rathbun with Dinwiddie.

As stated above, a *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

In order to reject under 35 U.S.C. § 103, therefore, the Examiner must provide a proper motivation for modifying the reference. *In re Rouffet*, 47 U.S.P.Q. 2d 1453, 1457-1458 (Fed. Cir. 1998); M.P.E.P. § 2142. The Examiner's motivation for modifying Mann with Rathbun and Dinwiddie to have a method for tracking activities where the activities are configurations of devices attached to the data processing system, as recited in claims 3, 11 and 15, is to "increase the functionality of system by communicating with and utilizing other devices." Paper No. 6, page 5. This is merely the Examiner's <u>subjective</u> opinion.

As stated above, Mann teaches maintaining an ordered list which can store any type and number of data items. Further, Mann teaches using the push or pop operation to insert and remove information in an ordered list where the ordered list comprises a plurality of index units, which includes cells to store items of data, stacked one on top of another in a linear fashion.

As stated above, Rathbun teaches using the insert and remove operation to insert or remove data in an ordered list in a parallel fashion by having the ordered list include sublists.

Dinwiddie teaches two virtual operating systems executing a single system environment without significant rewriting of either virtual operating system. Abstract.

The Examiner must submit objective evidence and not rely on his own subjective opinion in support of combining Mann, which teaches maintaining an ordered list comprising a plurality of units stacked one on top of another in a linear fashion, with Rathbun, which teaches maintaining an ordered list comprised of sublists using parallel processing, with Dinwiddie, which teaches merging two virtual operating systems in a single system environment without significant rewriting of either virtual operating system. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Mann to include a method of tracking activities where the activities are configurations of devices attached to the data processing system. *Id.* Further, the Examiner must submit objective evidence not relying on his own subjective opinion in support of modifying Mann to increase the functionality of the system by communicating with and utilizing other devices. *Id.* Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 3, 11 and 15.

F.　　Conclusion regarding 35 U.S.C. § 103 rejections.

As a result of the foregoing, Applicants respectfully assert that there are numerous claim limitations not taught or suggested in the cited prior art, and thus the Examiner has not presented a *pima facie* case of obviousness for rejecting claims 1-3 and 9-16 in view of the cited prior art.
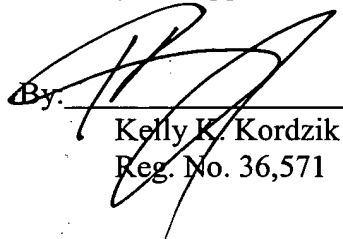
II.   CONCLUSION

As a result of the foregoing, it is asserted by Applicants that claims 1-3 and 9-16 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims.   Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorney for Applicants

By:

Kelly K. Kordzik
Reg. No. 36,571

P.O. Box 50784
1201 Main Street
Dallas, Texas 75250-0784
(512) 370-2851

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